

REMARKS

Claims 1-22 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-22 under 35 U.S.C. § 103 as being unpatentable over "Java Native Interface Specification" in view of U.S. Patent No. 6,263,377 to Monday and U.S. Patent No. 5,734,483 to Sanders. This rejection is respectfully traversed.

With respect to Claim 1 (and dependent claims thereof), none of the cited references teach or suggest the claimed feature of storing the selection of classes (as selected using a browser interface) such that the selection of classes is used by the browser when initializing the virtual machine. In effect, the claimed invention is directed to a technique for selection of classes using a browser interface for subsequent use by the browser when initializing a virtual machine. None of the cited references teach or suggest such capability, which greatly enhances system usability by providing a convenient interface which allows for selection of classes used by a browser when initializing a virtual machine.

The Examiner cites Monday Col. 3, lines 30-56 as teaching a GUI that allows for selection of classes. Notably absent from this assertion is any discussion regarding use of these selected classes for initializing a virtual machine. That is because there is no such teaching or suggestion. Monday merely retrieves the selected class for immediate execution. For example, Monday states at Col. 3, lines 38-41:

"The distributed application manager 132 checks the environment variable CLASSPATH for a set of directorics to browse for the selected class file, Corel Word Processor, San Francisco Payroll Entry."

This is the traditional use of the CLASSPATH environment variable which contains a list of directories to be searched for a given class file. Monday goes on to state at Col. 3, lines 41-43:

“If the selected x.class is located, then read the file in, parse it and return a pointer to the requested application.”

Again, this is the traditional technique of file location using the CLASSPATH environment variable, where the located class is returned to the requesting application for execution by such application. While Monday does teach that if a selected class file is found remotely, a copy of the found class file is written into a local CLASSPATH directory such that the class file is maintained locally (Monday Col. 3, lines 54-56), it does not teach or suggest that the *selection of classes* is stored such that the selection is used by the browser when initializing a virtual machine, as claimed. As there is a missing claimed feature even when combining these three cited references, it is shown that Claim 1 is not obvious in view of the cited reference.

In addition, the fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no suggestion in the cited art of any desire to modify such teachings in accordance with the claimed invention.

Further, when an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. “...absence of such suggestion to combine is dispositive in an obviousness determination”. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997). The Examiner states it would have been obvious to provide a user interface as taught by Monday to the Java Specification teachings because this provides an aesthetically pleasing user interface. However, Applicants show that the Java Specification is an API Specification, otherwise known as an application programming interface. It defines how an application program (i.e. software program) interacts/interfaces with the underlying Java operating system. It is a

computer software to computer software interface, so there would have been no reason to provide an aesthetically pleasing user interface because a human does not interface with the teachings of the Java API Specification. It is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claims as a "blueprint". When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). As there is no reason to provide an aesthetically pleasing user interface to the Java Specification teachings, the Examiner must be using Applicants' own patent specification as a blueprint to reconstruct the claimed invention, which is improper hindsight analysis. Hence, Claim 1 is further shown to have been erroneously rejected.

The features of Claim 1 advantageously provide an improved browser. Presently available browsers are designed with a notion of a fixed Java virtual machine, which uses a fixed value for the Java classpath. Until now, no flexible mechanisms were available for modifying the classpath within a browser (Specification page 5, lines 3-7). With this enhanced browser functionality according to the claimed invention – and in particular the claimed feature of storing the selection of classes (as selected using a browser interface) such that the selection of classes is used by the browser when initializing the virtual machine – users can easily adapt their browser to use more recent versions of a virtual machine such as the Java virtual machine upon a subsequent initialization. None of the cited references teach or suggest such capability or feature.

Further with respect to Claim 6, none of the cited references teach or suggest the claimed feature that the selection of classes (which are received through an interface, stored, and used for virtual machine initialization) is a class path. In rejecting Claim 6, the Examiner states that Java teaches the selection of classes is a class path as it teaches initialization arguments including a classpath that determines the local directory path for loading classes. Applicants show that Claim 6 goes further than this assertion, and includes the features of an interface which allows for selection of a class path, receiving the selected class path through an interface, and storing the selected class path which is used by the browser when initializing the virtual machine. In contrast, Java's description

of class path is the traditional specification of a class path using a command line parameter. This does not teach or suggest use of a browser interface for selection of a class path and storing it for subsequent use during virtual machine initialization, as claimed. Hence, Claim 6 is further shown to not be obvious in view of the cited references.

With respect to Claim 8 (and dependent Claims thereof), Applicants show that none of the cited references teach or suggest the claimed step of 'displaying a graphical user interface in which a classpath may be selected to define classes for use with a Java virtual machine', or the claimed steps of storing this selection and using it when initializing the Java virtual machine. In rejecting Claim 8, the Examiner states this is merely the combination of Claims 1 and 3, and relies upon the reasoning of Claims 1 and 3 in rejecting Claim 8. Applicants show error, in that Claim 8 is not merely a combination of Claims 1 and 3. Rather, Claim 8 recites use of a graphical user interface in which a *classpath* may be selected, where the Java virtual machine is initialized using the selection of the class path. The Examiner's statements regarding Claims 1 and 3 make no mention of classpath selection, but rather class selection. A class and a classpath are different things, and the teaching of one (class) does not teach or suggest the other (classpath). Monday merely teaches an interface for loading applications for immediate execution, and not an interface for specifying a classpath used for initializing a virtual machine, as claimed. Hence, a prima facie case of obviousness has not been made with respect to Claim 8. Absent such a prima facie showing, the burden has not shifted to Applicants to rebut obviousness.

Applicants further traverse the rejection of Claim 8 (and dependent claims thereof) for similar reasons to those given above regarding Claim 6.

With respect to Claim 12 (and dependent claims thereof), Applicants traverse for similar reasons to those given above regarding Claim 1.

Further with respect to Claim 17, Applicants traverse for similar reasons to those given above regarding Claim 6.

With respect to Claim 19, Applicants traverse for similar reasons to those given above regarding Claim 8.

With respect to Claim 20 (and dependent claims thereof), Applicants traverse for similar reasons to those given above regarding Claim 6.

Therefore, the rejection of Claims 1-22 under 35 U.S.C. § 103 has been overcome.


II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,


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